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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,614	06/04/2001	Shimon Silberfenig	0220-02C	5399

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LAW OFFICES OF ERIC KARICH
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MANSFIELD, TX 76063

EXAMINER

UBILES, MARIE C

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/874,614

Applicant(s)

SILBERFENIG ET AL.

Examiner

Marie C. Ubiles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2 and 3.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-3 and 5 rejected under 35 U.S.C. 102(e) as being anticipated by Detlef (US 6,351,523).

As for claim 1, Detlef discloses a combination cellular telephone, sound storage and email communication device (or *DC/PCS 12, Alphanumeric Paging and digital cellular (DC)/personal communications system*)(See Col. 4, lines 21-29); a controller operably connected to a power source (as read on "processing power"), a microphone (as read on "voice memo function"), a speaker (as read on "voice memo function"), and a transmitter/receiver for enabling cellular telephone communications (as read on

"cellular telephones")(See Col. 3, line 64 through Col. 4, line 6); a voice recorder memory operably connected to the controller for recording a voice message (See Col. 3, lines 55-56); an email address memory operably connected to the controller (or *email server 36 and lookup table 40*)(See Col. 3, lines 56-58); a means for receiving an email address into the email address memory into the email address memory (See Col. 4, lines 35-37); and a means for transmitting the voice message and the email address, the email address being associated with the voice message such that the voice message can be delivered as directed by the email address (See Col. 4, lines 37-40).

As for claim 2, Detlef discloses means for receiving including a display (or display 60, Fig. 2) connected to the controller for receiving the email address into the email address memory (See Col. 5, lines 13-25). As for the "keypad", while not directly disclosed by Detlef, it is well-known in the art that keypads, keyboards and/or screen buttons exist in cell phones and PDA to perform email-related functions.

Claims 3 and 5 are rejected for the same reasons as claim 1.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Detlef (US 6,351,523) in view of Finnigan (US 5687220).

Detlef discloses the system as claimed except for "receiving the voice message and the email address at a message center; converting the voice message into a text message; composing an email including the text message and addressed to the email address; and transmitting the email such that the text message is delivered to the email address."

In regards to that, Finnigan teaches "If a voice message system 10 includes a voice recognition and conversion subsystem, the selectable voice message transmission instructions can include converting voice messages to text data suitable for delivery as electronic mail to a selected electronic mailbox." (See Col. 5, lines 39-43).

It would have been obvious to one of ordinary skill in the art to modify Detlef's system with the teaching of Finnigan and thus in this manner provide a system in which messages voice messages may be delivered as electronic mail to a selected electronic mailbox.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

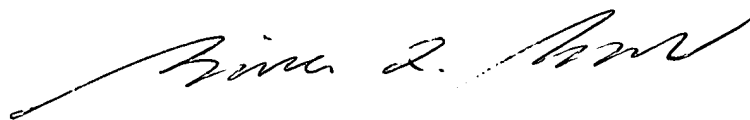
O'Cinneide (US 6,138,036) teaches a wireless telephone with voice data interface mode.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marie C. Ubiles whose telephone number is (703) 305-0684. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marie C. Ubiles
July 28, 2004



**BING Q. BUI
PRIMARY EXAMINER**